

REMARKS

Reconsideration of the application is respectfully requested in view of the amendments and the discussion presented below. The amendments are supported by the application as filed and no new matter has been added by any of the amendments.

The specification is amended as requested by the Examiner. Additional amendments to the specification correct typographical mistakes and other informalities. The penultimate paragraph in the specification, for example, was inadvertently included from another and unrelated application.

Claims 1, 11, and 12 are amended by adding the limitations of original claim 6. Claims 2, 3, and 6 are cancelled without prejudice.

Claims 1, 4, 5, and 7-12 are now present in this application.

Discussion

1. The Objection to the Specification

The Examiner objected to the specification for minor typographical errors, such as the use of the word "characteristics" instead of "characteristic" in paragraph 0058 of the corresponding patent publication, "coincide" instead of "coincides" in paragraph 0076, and "lever" instead of "level" in paragraph 0085. Other errors in the specification have also been corrected. The specification is amended to correct these informalities and the objection should therefore be withdrawn.

2. The Rejection of Claims 1, 2, 4, 5, 7, and 10-12 over Yanagawa in view of Yamanaka

The Examiner rejected claims 1, 2, 4, 5, 7, and 10-12 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2001/0026522 to Yanagawa

("Yanagawa") in view of U.S. Patent 6,771,584 to Yamanaka ("Yamanaka"). The Examiner did not consider the combination of Yanagawa and Yamanaka to teach or suggest the limitations of claim 6. See pages 6 and 7 of the office action. Claims 1, 11, and 12 are independent claims and have been amended by adding to them the limitations of claim 6. Claims 1, 11, and 12, as amended, are patentable over the combination of Yanagawa and Yamanaka for at least for this reason. Claim 2 is cancelled without prejudice. Claims 4, 5, 7, and 10 depend directly or indirectly from claim 1 and are therefore allowable over the combination of Yanagawa and Yamanaka for at least for this reason.

The rejection of claims 1, 4, 5, 7, and 10-12 as being unpatentable over Yanagawa and Yamanaka should be withdrawn.

3. The Rejection of Claims 3 and 8 over Yanagawa in view of Yamanaka and further in view of Hayashi, et al.

The Examiner rejected claims 3 and 8 under 35 U.S.C. 103(a) as being unpatentable over Yanagawa in view of Yamanaka as applied to claims 1 and 7 and further in view of U.S. Patent Publication 2001/0040853 to Hayashi, et al. ("Hayashi, et al.").

Claims 3 and 8 depend from claim 1. As discussed above, claim 1 has been amended to add the limitations of claim 6. The Examiner admits that the combination of Yanagawa and Yamanaka do not teach or suggest the limitations of claim 6 and has not suggested that Hayashi, et al. teaches or suggests these limitations.

The rejection of claims 3 and 8 as being unpatentable over Yanagawa in view of Yamanaka as applied to claim 1 and further in view of Hayashi, et al. should be withdrawn.

4. The Rejection of Claim 6 over Yanagawa in view of Yamanaka and further in view of Furukawa

The Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Yanagawa in view of Yamanaka as applied to claim 4 and further in view of U.S. Patent 6,643,230 to Furukawa ("Furukawa").

To establish a *prima facie* case of obviousness, the Examiner must show: (1) that there is some suggestion or motivation to modify the reference or to combine reference teachings; (2) that there is a reasonable expectation of success; and (3) that the prior art reference or references teach or suggest each and every claim limitation. *See* MPEP 2142. Further, the suggestion or motivation to modify or combine and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. The Applicants submit that the Examiner has neither adequately shown a motivation to combine the references in the manner done by the Examiner nor has the Examiner shown that the asserted combination teaches each and every element of the rejected claim 6. Therefore, the Applicants submit that the Examiner has not established a *prima facie* case of obviousness based on the cited prior art, and claim 6 is patentable over these cited references.

The Applicants will explain below that claim 6 is allowable over Yanagawa in view of Yamanaka as applied to claim 4 and further in view of Furukawa. Although claim 6 has been canceled, its limitations have been added to the independent claims 1, 11, and 12 and therefore a discussion of its patentability in view of the cited references is in order.

As the Examiner understands, neither Yanagawa nor Yamanaka teach or suggest the limitations recited in the original claim 6. That is, neither Yanagawa nor Yamanaka teaches or suggests a "characteristic obtaining unit [which] is configured to detect a pit

level and at least one of a read level, a write level and a recording power according to a light reflected from the optical recording medium while the test recording unit performs the test recording, and to obtain the characteristic of the pit ratio, the parameter including the pit level, the read level, the write level and the recording power, the pit ratio representing the ratio of one of the read level or the write level to the pit level."

The Examiner interprets "residual error value" described in Furukawa as "the pit level" of the original claim 6. Further, he interprets the "amplitude width value of the disturbance signal" described in Furukawa as "one of the read level, the write level, and a recording power" of the original claim 6. It is respectfully submitted that the Examiner's understanding is incorrect.

Furukawa obtains a tracking error signal by outputting the difference between light receiving devices A to D the photodetector 28 described in FIG. 3 (please see col. 3, lines 17-24 and 60-64). Then, Furukawa generates an oscillation signal as a disturbance signal, and adds the disturbance signal to the tracking error signal (please see col. 3, line 65 to col. 4, line 2). Furthermore, Furukawa extracts only the band component of the disturbance signal from the disturbance superimposed tracking error signal. This component is obtained as a "servo residual error value" signal (please see col. 4, lines 11-14). Then, Furukawa determines the ratio of a "servo residual error value" signal to "the amplitude width value of the disturbance signal." This ratio is set as a tracking servo gain value (please see col. 4, lines 15-24).

On the other hand, claim 6 requires detecting "a pit level and at least one of a read level, a write level, and a recording power" from "a light reflected from the optical recording medium while the test recording unit performs the test recording." Therefore, all of the "pit level", "read level" and "write level" are detected from the reflected light.

These levels are different from the tracking error signal and disturbance signal of

Furukawa. In order to obtain Furukawa's tracking error signal, it is necessary to calculate the differences between the outputs of the photodetectors as explained above. Further, if the optical beam does not cross any tracks, it is impossible to obtain the tracking error signal. Furthermore, claim 6 does not require adding any signal such as a disturbance signal to detected signal. Furukawa intentionally generates the disturbance signal. Thus, the "pit level," "read level," and "write level" are totally different from the tracking error signal and disturbance signal from a technological point of view.

Consequently, Furukawa does not disclose, teach, or suggest the features recited in the original claim 6 at all. Since the limitations of the original claim 6 have been added to claims 1, 11, and 12, the combination of Yanagawa in view of Yamanaka as applied to claim 4 and further in view of Furukawa does not disclose, teach, or suggest the combinations of limitations recited in the amended claims 1, 11, and 12, or any claim depending from those claims.

The Examiner also has not provided an adequate "suggestion or motivation to modify the reference or to combine reference teachings." Yanagawa, Yamanaka, and Furukawa each purport to teach what the Examiner calls "means for accurate reading of information even if spherical aberration were generated by the thickness error in the transparent substrate of an optical disk." See Yanagawa at paragraphs 0006 and 0007, Yamanaka at col. 2, lines 10-26 and col. 3, lines 2-7, and Furukawa at col. 2, lines 19-27 and 29-35. The Examiner has not explained why a person of ordinary skill in the art would combine various features of *three* such systems other than forbidden hindsight.

Claims 1, 11, and 12 are therefore patentable over Yanagawa in view of Yamanaka as applied to claim 4 and further in view of Furukawa. The rest of the remaining claims in this application depend from claim 1 directly or indirectly and are therefore patentable as well.

5. The Rejection of Claim 9 over Yanagawa in view of Yamanaka and further in view of Nishi

The Examiner rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Yanagawa in view of Yamanaka as applied to claim 7 and further in view of U.S. Patent Publication 2004/0174781 to Nishi ("Nishi").

Claim 9 depends on claim 7 that in turn depends on claim 1. As discussed above, claim 1 has been amended to add the limitations of claim 6. The Examiner admits that the combination of Yamagawa and Yamanaka do not teach or suggest the limitations of claim 6 and has not stated that Nishi teaches or suggests these limitations.

The rejection of claim 9 as being unpatentable over Yanagawa in view of Yamanaka as applied to claim 7 and further in view of Nishi should be withdrawn.

6. The Reference Made of Record

The reference made of record but not applied to the claims is not believed to teach or suggest the claimed subject matter.

Conclusion

In view of the above, the Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue. The Examiner is respectfully invited to telephone the undersigned attorney as needed in order to advance the examination of this application.

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The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this

response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

August 7, 2006.

Date of Transmission

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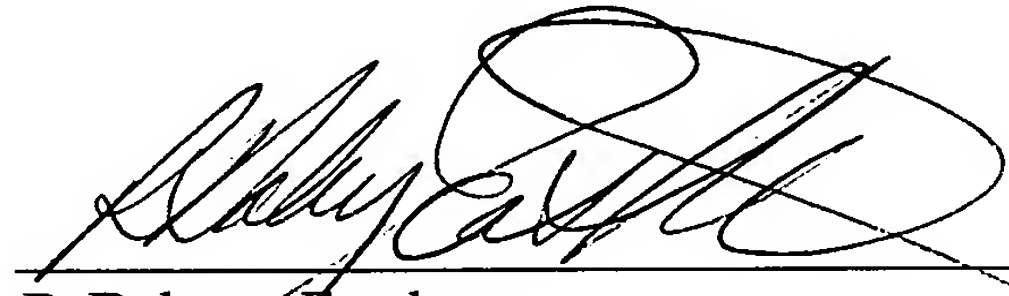
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August 7, 2006

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Respectfully submitted,



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